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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,276	09/24/2003	Stephen B. Roscoe	58917US002	6568
32692 7590 01/10/2008 3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427			EXAMINER SIEFKE, SAMUEL P	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/669,276
Filing Date: September 24, 2003
Appellant(s): ROSCOE ET AL.

MAILED
JAN 10 2008
GROUP 1700

Bradford B. Wright
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10/11/07 appealing from the Office action mailed 5/16/07.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,490,415	Mak et al.	2-1996
4,511,534	Bennett, Jr. et al.	4-1985
5,591,636	Grass	1-1997

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-18, 20, 42, 43, 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mak et al. (USPN 5,490,415) in view of Bennett, Jr. et al. (USPN 4,511,534).

Mak teaches a diffusion test apparatus that comprises a first base (22) having a plurality of hollow projections (30) extending outwardly from a first surface (12), each hollow projection having a tapered tip (see fig. 2, ref. 26) with an opening (28) therein and a respective cavity contiguous with the opening disposed within the projection (fig. 2); a second base (36) having a first surface having a plurality of recessed tapered openings therein adapted to engage the plurality of hollow projections; a membrane contacting the recess tapered openings and the tips of the hollow projections, the first base being fastened to the second base by fasteners (14). The first base and the second base are transparent because they can be made from glass (col. 6, lines 37-39).

The fastener means (clip) 14 is removable when the membrane is changed. The hollow projections extend through the first base and form an opening at the second surface of the first base (fig. 2 and 3). Regarding claim 5, a first covering means fastened to the second surface of the second base can be seen as plugs 48 that are inserted into the openings 38. Regarding claim 8, the bottom of the first base 22 is an equivalent to the cover 578 of the instant application in that it closes the openings in the first base. The cover plate (bottom of first base) is transparent because it is made from glass. The tapered tips have a beveled proportion (fig. 2). The membrane composition is discussed in column 6, lines 43-50 and can be a synthetic membrane (polymeric), animal, skin, etc.

Mak does not teach a retaining plate for retaining the membrane only to the second base.

Bennett teaches a liquid transfer device that comprises a second base 32 and a retaining plate 42 which holds a membrane to the second base 32 by removable fasteners 42 as seen in figure 2-4. Bennett provides this configuration for quick and easy movement of the membrane from one container to the next. It would have been obvious to one having an ordinary skill in the art at the time of the invention to modify Mak to employ a retaining plate to hold the membrane to the second base (4) to allow for easy removal of the second base and membrane together in order to gain access to the diffused liquid in the first base (6) in one step. This would reduce the number of steps a user would incur to gain access to the diffused liquid and decrease fumbling around with expired membrane (contaminated) being separate from the second base.

Claims 1-18, 20, 42, 43, 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mak et al. (USPN 5,490,415) in view of Grass (USPN 5,591,636).

Mak teaches a diffusion test apparatus that comprises a first base (22) having a plurality of hollow projections (30) extending outwardly from a first surface (12), each hollow projection having a tapered tip (see fig. 2, ref. 26) with an opening (28) therein and a respective cavity contiguous with the opening disposed within the projection (fig. 2); a second base (36) having a first surface having a plurality of recessed tapered openings therein adapted to engage the plurality of hollow projections; a membrane contacting the recess tapered openings and the tips of the hollow projections, the first base being fastened to the second base by fasteners (14). The first base and the second base are transparent because they can be made from glass (col. 6, lines 37-39). The fastener means 14 is removable when the membrane is changed. The hollow projections extend through the first base and form an opening at the second surface of the first base (fig. 2 and 3). Regarding claim 5, a first covering means fastened to the second surface of the second base can be seen as plugs 48 that are inserted into the openings 38. Regarding claim 8, the bottom of the first base 22 is an equivalent to the cover 578 of the instant application in that it closes the openings in the first base. The cover plate (bottom of first base) is transparent because it is made from glass. The tapered tips have a beveled proportion (fig. 2). The membrane composition is discussed in column 6, lines 43-50 and can be a synthetic membrane (polymeric), animal, skin, etc.

Mak does not teach a retaining plate for retaining the membrane to the second base.

Grass teaches a membrane holder that comprises an upper base 14, a retaining plate 18 and a lower base 16. A membrane is placed between the upper base and the retaining plate 18 and held together by means of a threaded connection between the upper base and the retaining plate (col. 3, lines 44-50). The retaining plate is attached to the base plate by bolts 20. It would have been obvious to one having an ordinary skill in the art at the time of the invention to modify Mak to employ a retaining plate to hold the membrane to the second base (4) to allow for easy removal of the second base and membrane together in order to gain access to the diffused liquid in the first base (6) in one step. This would reduce the number of steps a user would incur to gain access to the diffused liquid and decrease fumbling around with expired membrane (contaminated) being separate from the second base. Mak is only interested in the diffused liquid that remains in the first base (6) as seen in col. 3, lines 45-49 because the sample is thereafter analyzed by conventional scintillation countering techniques.

Response to Arguments

Appellant argues, "Mak is explicitly intended for single use" and therefore teaches away from combining with Bennett to allow for moving the membrane and second base to another first base to measure diffusion across the membrane with a second liquid." It is noted that Appellant recites limitations on the manner in which the

retaining plate is used. Such limitations are not attributed patentable weight in claims to a device. The Examiner maintains that it would be desirable to retain the membrane that is being sampled on the second base (4) when the diffusion reaction is expired because when the end point has come a user disassembles the assembly by removing the clasp 14 and removes the second base (4) and the membrane to gain access to the liquid that has diffused through the membrane and into the first base (6). It would have been obvious to one having an ordinary skill in the art at the time of the invention to employ a retaining plate to hold the membrane to the second base (4) to allow for easy removal of the second base and membrane together to gain access to the diffused liquid in the first base (6) in one step instead of fumbling around with the membrane being separate from the second base.

In response to Appellant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the Appellant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). The Examiner maintains that there is sufficient motivation to combine the reference to teach the claimed device of the instant application.

In response to applicant's argument that Bennett, Jr. et al. is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's

endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Mak is concerned with testing a fluid sample on a membrane while Bennett, Jr. is concerned with a device that retains a membrane to a second base.

Appellant argues, "it is still submitted that adding a retaining plate to the device of Mak would have no purpose and would add unneeded complexity." The Examiner disagrees with the Appellant's statement because the modified Mak given the motivation to employ a retaining plate describes the Appellant's invention. If the Appellant intends to make this statement regarding modified Mak, then the instant application has unneeded complexity and has no purpose. The modified Mak teaches all the necessary structures that make it structurally capable of performing the instant invention.

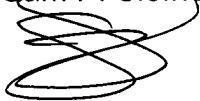
(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Sam P. Siefke



Conferees:

Lyle Alexander



**LYLE A. ALEXANDER
PRIMARY EXAMINER**

Greg Mills


**GREGORY MILLS
QUALITY ASSURANCE SPECIALIST**